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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,842	03/15/2005	Steven Edward Ireland	341305-1010	1890

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EXAMINER

SMITH, RICHARD A

ART UNIT	PAPER NUMBER
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2859

DATE MAILED: 08/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/527,842	IRELAND, STEVEN EDWARD	
	Examiner	Art Unit	
	R. Alexander Smith	2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-6 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over FR 2,485,442 to Delcour in view of US 4,448,310 to Hodgson and US 3,381,654 to Hupp et al.

Delcour discloses a bookmark comprising

a thin flat substantially rectangular body (2 of figure 5) having a periphery defined by two long sides and two short sides;

an indicator(s) comprising a thin, flat collar (4) in frictional contact with the rectangular body wherein the indicator is movable along a length of the rectangular body; the indicator having two parallel cuts (10) of such a length that the rectangular body may be interlaced with the indicator(s);

the indicator formed from a sheet of material and having a front side, a back side, and two cuts (10) extending from the front to back sides, the cuts being located with the periphery such that the collar is defined by a contiguous frame that surrounds the two cuts, the two cuts being of a length that the rectangular body may be interlaced with the indicator such that the body extends from the front side of the indicator through a first of said cuts to a back side and then through a second of the cuts to the front side (as shown in figure 5);

an intermediate portion of each of the two cuts being parallel to the other.

Delcour does not disclose

a thin flat rectangular tab formed by two parallel cuts and a lower cut,

a thin flat rectangular tab defined by two opposing cuts and said lower cut wherein the tab is displaceable out of the rectangular body such that the bookmark may be restrained,

the each of the indicators being formed by cutting or punching blanks,

the tab having the parallel cuts curved inwardly,

each of the parallel cuts being curved inwardly for a short distance near their ends thus forming curved tabs that operate as opposing frictional bearing surfaces upon which the long edge of the rectangular body impinge;

at least a portion of the rectangular body is positioned between each curved tab and the front of the indicator,

said intermediate portion being located between curved tabs for each of the two cuts.

Hodgson discloses a bookmark having a thin flat rectangular tab (49) formed by two parallel cuts and a lower cut and defined by two opposing cuts and said lower cut wherein the tab is displaceable out of the rectangular body such that the bookmark may be restrained (as shown in figures 3 and 4). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the bookmark, taught by Delcour, to include a tab, as taught by Hodgson, in order to restrain the bookmark in place on the page.

Hupp et al. discloses a bookmark made of a flexible material such as plastic sheet, and discloses for figures 9-12 that the ends 57, 58, 64 and 65 are curved inwardly in semi-circular curved cuts without removal of any material in order to reduce stress concentration of any pulling or bending of the tongues, to provide spacing for trapping the pages (holding tongue 53 and that provides space for the pages when used as the clip portion described in column 3 lines 55-68), and that no material being removed helps prevent interference with the die cutting processes and that any material can be used including paper and various resinous plastics (column 3 line 52 - column 4 line 18). Furthermore, Hupp et al. discloses that these inwardly

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curved cuts allow the deflection of the adjoined portions 59 and 69, i.e., tabs, to provide an effective grip on the pages of book by the clip portion.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the bookmark, taught by Delcour and Hodgson, to incorporate the inward curves to defined curved tabs at ends of the tab and at the ends of the two cuts with the intermediate portion therebetween in order to allow the curved tabs to operate as opposing frictional bearing surfaces while still allowing movement, to reduce stress concentration and to prevent damage and tearing, as taught by Hupp et al.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to cut or punch the bookmark, as taught by Hupp et al., in order to save on costs of material, to provide a technique to cut or punch the bookmarks without interfering with the cutting process, and to help prevent damage or tearing of the pages of the book.

Response to Arguments

3. Applicant's arguments filed June 5, 2006 with respect to Lopes and Sager have been considered but are moot in view of the new ground(s) of rejection.

4. Applicant's arguments filed June 5, 2006 with respect to Hupps et al. in combination have been fully considered but they are not persuasive.

Applicant's argument with respect to the abstract and a different problem is noted, however this argument is not persuasive since Hupps et al. is analogous by teaching a lower tab that is intended to grip the pages. This lower tab includes the curved ends which define curved tabs 59 and 69 which are designed to frictional engage a sheet of material located within the tab as discussed in column 3, lines 52-74 while reducing stress concentration.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. Alexander Smith whose telephone number is 571-272-2251. The examiner can normally be reached on Monday through Friday from 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F. Gutierrez can be reached on 571-272-2245. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'R. Alexander Smith', with a long horizontal stroke extending to the right.

R. Alexander Smith
Primary Examiner
Technology Center 2800

RAS
August 15, 2006